

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHANNON S. MORRIS

Appeal No. 2000-0293
Application No. 08/766,862

ON BRIEF

Before FRANKFORT, GONZALES, and CRAWFORD, Administrative Patent Judges
CRAWFORD, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 17, which are all of the claims pending in this application.

The appellant's invention relates to a jewelry organizer. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The prior art

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Martire Jr.	2,878,932	Mar. 24, 1959
Coon	4,632,351	Dec. 30, 1986
Gatt	4,944,398	Jul. 31, 1990
Grusin	5,040,681	Aug. 20, 1991

The rejections

Claims 1 through 17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Claims 1, 2, 4 through 8, and 12 through 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Martire in view of Gatt and Grusin.

Claims 3 and 9 through 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Martire, Gatt and Grusin as applied to claims 2 and 8 above, and further in view of Coon.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed June

2, 1999) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 11, filed March 10, 1999) and reply brief (Paper No. 13, filed August 4, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The examiner has rejected claims 1 through 17 under 35 U.S.C. § 112, second paragraph. The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

As noted by the Court in In re Swinehart, 439 F.2d 210, 212-13, 160 USPQ 226, 229 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. The examiner states that:

Regarding claims 1, 8 and 14, the phrase "such as" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. . .
In claim 2, the phrase "plate-like" is

indefinite because it is not clear as to what structure is encompassed or excluded by such term "like". [examiner's answer at page 4].

The specification teaches that the jewelry organizer of the invention has an upper surface 12 for storing and displaying several types of jewelry (Specification at page 1). The specification indicates that the jewelry that is stored in the organizer may be necklaces, earrings, watches, bracelets and rings (Specification at page 3). We agree with the appellant that a person of ordinary skill in the art would have understood the term "such as" in claims 1, 8 and 14 to indicate examples of the types of jewelry that can be stored in the organizer. As such, in our view, the scope of claims 1, 8, and 14 can be determined with a reasonable degree of certainty.

Therefore, we will not sustain the examiner's rejection of claims 1, and 4 through 17 as being indefinite under 35 U.S.C. § 112, second paragraph.

In regard to the language "plate-like structure" in claim 2, we are of the opinion that the scope of the claimed subject matter cannot be determined from this language with a reasonable degree of certainty. Specifically, it is not clear whether this language refers to dinner plate structure, flat rectangular plate structure, picnic plate structure which includes compartments or some other

plate structure. As such, we agree with the examiner that the language of claim 2 does not satisfy the requirements of 35 U.S.C. § 112, second paragraph.

Therefore, we will sustain the examiner's rejection under 35 U.S.C. § 112, second paragraph, of claim 2 and claim 3 dependent thereon.

We turn next to the examiner's rejection of claims 1, 2, 4 through 8 and 12 through 17 as being unpatentable under 35 U.S.C. § 103 over Martire in view of Gatt and Grusin. The examiner has relied on Martire for teaching the invention substantially as claimed except that Martire does not disclose a knob protruding upward from the upper surface. The examiner relies on Gatt and Grusin for teaching a knob protruding upward from the upper surface. The examiner concludes:

It would have been obvious to one having ordinary skill in the art in view of Gatt and Grusin to modify the organizer of Martire '932 so the knob is protruded upwardly from the upper surface with a recess formed in the lower surface of the body to facilitate stacking, and better securing the trays within the stack during shipping or storage. [examiner's answer at page 6]

Appellant argues that the Martire tray already has means for stacking the trays in that Martire discloses a substantially planar

surface 4 with an upturned peripheral edge portion 6 that permits the trays to be stacked on top of one another. As such, appellant argues that it would have been pointless to consider adding a knob in the upper surface of the Martire tray for purposes of stacking.

We agree with the appellant that there would be no motivation to include a knob in the upper surface of the Martire tray as taught by Gatt and Grusin to facilitate stacking because the Martire tray is already stackable (See Col. 3, lines 58 to 61). In addition, we note that Martire teaches that one of the advantages of the tray therein disclosed is its flexibility to be used as a standard tray and not be rigidly limited to the relative positions of the food receptacles on the tray (Col. 2, lines 11 to 14). As such, in our view, a person of ordinary skill in the art would not be motivated to modify the Martire tray so as to have a knob in its upper surface, because such modification would reduce the ability of the tray to be used as a standard tray and limit the positions in which the food receptacles could be placed on the tray.

Therefore, we will not sustain the examiner's rejection of claims 1, 2, 4 through 8 and 12 through 17 under 35 U.S.C. § 103 as being unpatentable over the teachings of Martire, Gatt and Grusin.

We turn now to the examiner's rejection of claims 3 and 9 through 11 under 35 U.S.C. § 103 as being unpatentable over Martire, Gatt and Grusin and further in view of Coon. We have examined the disclosure of Coon and find that Coon does not cure the deficiencies discussed above for the combination of Martire, Gatt and Grusin. Therefore, we will not sustain this rejection.

New ground of rejection

Under the authority of 37 CFR § 1.196(b), this panel of the board introduces the following new ground of rejection.

Claims 1 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by Grusin. Grusin discloses a body 18 having an upper surface and a lower surface. A knob 30 protrudes upwardly from the upper surface. At least one compartment 34 defined by an elongated channel surrounding the knob is formed in the upper surface. A substantially flat outer rim (upper surface 32 and/or rib 38,40) surrounds the periphery of compartment 34. A recess is formed in the lower surface of body 18 wherein the recess and knob provide means for stackable configuration (See Col. 3, lines 26-29).

Remand to the Examiner

This application is remanded to the Primary Examiner for consideration of the patentability of claims 2 through 7 and 9 through 17 in view of the teachings of Grusin alone or in combination with other relevant prior art references.

In summary:

(1) The examiner's rejection of claims 1 and 4 through 17 under 35 U.S.C. § 112, second paragraph, is not sustained.

(2) The examiner's rejection of claims 2 and 3 under 35 U.S.C. § 112, second paragraph, is sustained.

(3) The examiner's rejection of claims 1, 2, 4 through 8, and 12 through 17 under 35 U.S.C. § 103 as being unpatentable over Martire in view of Gatt and Grusin is not sustained.

(4) The examiner's rejection of claims 3 and 9 through 11 under 35 U.S.C. § 103 as being unpatentable over Martire, Gatt and Grusin and further in view of Coon is not sustained.

(5) Claims 1 and 8 are rejected pursuant to our authority under 37 CFR § 1.196(b).

(6) The application is remanded to the examiner.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) and a remand pursuant to 37 CFR § 1.196(e).

37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(e) provides that:

[w]henever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, the decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months form the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to

avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

The effective date of the affirmance is deferred until conclusion of the proceedings before the examiner unless, as a mere incident to the limited proceedings, the affirmed rejection is overcome. If the proceedings before the examiner do not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely filed request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART AND REMANDED
37 CFR § 1.196(b)

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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